



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/627,278 | 07/25/2003 | Keith S. Warren | 131-65548 | 4109 |

7590 02/23/2004
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,278

Applicant(s)

WARREN, KEITH S.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 7/25/03*
- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/25/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

K. L. Bell

Detailed Action

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

Detailed Action

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 5-10 should be deleted as there is no information to be set forth.

B. Page 1, line 19 to page 2, line 5, Applicant should set forth in the specification the origin of the instant tree. It is noted that applicant has stated the instant tree's seed parent is "*Amelanchier laevis*" and the pollen parent is "Open pollinated, believed to be *Amelanchier laevis*" on page 3, lines 2 and 3. The first recitation is unclear as it is not understood whether the seed parent is the entire Genus/species or a named or unnamed plant of *Amelanchier laevis*. If named, applicant should set forth the name of the plant in the specification. If unnamed, applicant should simply state - an unnamed tree of *Amelanchier laevis* -. The second recitation is unclear

Detailed Action

as it is not understood whether the pollen parent was open pollinated or the instant tree originated from an open pollination. The origin of the tree should be clearly and unambiguously set forth in the specification.

C. Page 1, line 26, Applicant should delete "notice" and insert - -noticed- -.

D. Page 2, lines 5 and 6, In addition to stating "combination of characteristics that have proven fixed in asexual progeny", applicant should state - -The new tree reproduces true to type in successive generations of asexual reproduction.- -, if accurate.

E. Page 3, line 24, Applicant should set forth in the specification additional information relative to the instant tree's branches including the typical and observed branch length and diameter.

F. Page 5, lines 14 and 15, Applicant should set forth in the specification additional information relative to the instant tree's flower including the typical and observed flower depth.

G. Page 5, line 27, Applicant states "Calyx green (RHS 143B)". This recitation can be deleted as this information has already been set forth at lines 25 and 26 of the same page.

Detailed Action

H. Page 5, line 28, Applicant should set forth in the specification additional information relative to the instant tree's petals including petal apex, margin, and base descriptor.

I. Page 5, line 29, Applicant states sepals are "(RHS 143A to 143B)". However, applicant has previously stated the calyx is "RHS 143B" on lines 26 and 27 of the same page and page 7, line 15. These recitations are contradictory. Correction and/or clarification is necessary.

J. Page 5, lines 29 and 30, Applicant should set forth in the specification additional information relative to the instant tree's sepals including the typical and observed sepal margin descriptor.

K. Page 6, line 2, Applicant should set forth in the specification the number of pistils per flower.

L. Page 6, lines 7 and 8, Applicant states pedicel color is "RHS 152B". However, applicant has previously stated the pedicel is "RHS 146A" on page 5, line 26. These recitations are contradictory. Correction and/or clarification is necessary.

Detailed Action

M. Page 6, line 10, Applicant states peduncle color is "RHS 183A" over a base color of yellow-green "RHS 146A". However, applicant has previously stated the peduncle is "RHS 146A" on page 5, line 26. These recitations are contradictory. Correction and/or clarification is necessary.

N. Page 6, lines 13 and 14, Applicant should set forth in the specification the lastingness of the bloom, on the plant.

O. Page 7, line 4, Applicant should delete "PP7,203" and insert - -U.S. Plant Patent number 7,203- - so as to clearly set forth that the Patent set forth is a U.S. Plant Patent.

P. Page 7, line 20, Applicant states earliest emerging leaf color is "RHS 176B to 176D". However, applicant has previously stated the earliest emerging leaf color is "RHS 176C to 176D" on page 4, line 25. These recitations are contradictory. Correction and/or clarification is necessary.

Q. Applicant should incorporate into the specification, by way of the amendment format stated below, the handwritten information set forth at page 2, line 22.

Detailed Action

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Applicant should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicant should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Serial Number: 10/627,278
Art Unit: 1661

Page 8

Detailed Action

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

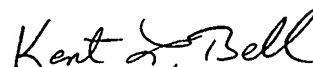
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Kent L. Bell".